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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,187	04/26/2001	Thomas M. Baer		2124

7590 02/17/2004

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EXAMINER


CROSS, LATOYA I

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/844,187	Applicant(s) BAER ET AL.	
	Examiner LaToya L. Cross	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-92 is/are pending in the application.
- 4a) Of the above claim(s) 14-78 and 83-92 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 79-82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of claims 1-13 and 79-82 (group I) in the Paper dated November 10, 2003 is acknowledged. The traversal is on the ground(s) that all of claims 1-92 could be examined without placing a burden on the Examiner. This is not found persuasive because as stated in the Restriction Requirement paper, each of the groups has different features that require different search strategy and search locations. It would indeed be burdensome for the Examiner to have to search for five different devices and the structural features of the different devices.

The requirement is still deemed proper and is therefore made FINAL. Claims 14-78 and 83-92 are withdrawn from consideration as being directed to non-elected subject matter.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3, 4, and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,277,648 to Colpan.

Colpan teaches a device for isolating cell components, such as nucleic acids. The device

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(according to figures 3 - 9) comprises a sample carrier (40) having a sample inlet (50) and a sample outlet (60). The sample carrier is mated with an extraction column (1). The extraction column includes a top portion within which the sample carrier can be received. When the sample carrier is mated with the extraction column, as shown in figure 3, a reservoir is formed. The Examiner considers the open space of the extraction column (1) to be equivalent to Applicants' claimed conduit. Figure 3 also shows that the reservoir includes a portion of the carrier and the conduit, as recited in claim 4. With respect to claim 3, Colpan teaches that the sample carrier and extraction column may be attached to the top of a vacuum to aid in the extraction process. With respect to claim 5, Colpan teaches that the carrier (40) is secured to the extraction chamber (1) due to frictional forces (col. 3, lines 47-53). With respect to the method of using the device, Colpan teaches a sample carrier being mated with an extraction device. A sample enters the carrier (40) and goes through a series of filter layers. The filtrate exits the carrier at outlet (60) and enters the extraction column (1), which may contain an extraction medium. See example 10.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be anticipated, within the meaning of 35 USC 102(e).

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 2, 6-13 and 79-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colpan in view of US Patent 5,985,085 to Baer et al.

The disclosure of Colpan is given above.

Colpan differs in that there is no disclosure of the carrier having a transfer film, where a portion of the film includes a stand-off portion. Baer et al teach a laser capture microdissection device comprising a sample carrier (300) and a laser capture microdissection transfer film (400). Baer et al disclose that the use of the transfer film facilitates quick and accurate laser capture microdissection while simultaneously minimizing contamination. It would have been obvious to use a transfer film to capture the sample because the transfer films allows the sample to be absorbed thereon and safely kept until further processing or analysis. The transfer film is especially useful where the sample is small in size. With respect to the transfer film having a stand-off portion, Baer et al teach that a stand-off rim may be present on the carrier to serve as a spacer between the transfer film and the sample to be captured. It would have been obvious to one of ordinary skill in the art to include a stand-off rim in the carrier of Colpan to prevent transferring of the sample to the transfer film until the transfer film is activated (col. 12, lines 35-49).

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Therefore, for the reasons set forth above, Applicant's claimed invention is deemed to be obvious, within the meaning of 35 USC 103, in view of the teachings of Colpan and Baer et al.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 571-272-1256.

The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Examiner.

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February 9, 2004

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700